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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/625,052	07/24/2000	Toshikazu Miyashita	043034/0155	6637

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FOLEY AND LARDNER
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3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER

YUN, EUGENE

ART UNIT	PAPER NUMBER
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2682

15

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/625,052

Applicant(s)

MIYASHITA, TOSHIKAZU

Examiner

Eugene Yun

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-8 and 12 is/are allowed.
- 6) ☒ Claim(s) 9-11 and 13-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/20/2004 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 9-11 and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bowers and Takagi in view of Constien (US 6,259,932).

Referring to Claim 9, Bowers teaches a portable apparatus comprising:

a display 24 (fig. 1);

an input device for inputting coordinate information to the portable apparatus to control a position of a cursor on the display, the coordinate information varying

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depending on a movement of the input device on a flat surface (see col. 5, lines 23-45);
and

a coupling mechanism 54 and 54a (fig. 2) for detachably coupling the input device to a predetermined portion 58 (fig. 2) of the information processing device, said input apparatus being removable from said information processing device for operation thereon to control the position of said cursor (see input apparatus 32 removed from information processing device 12).

The combination of Bowers and Takagi does not teach the portable apparatus being a portable telephone apparatus and coupling the input device to a handset of portable telephone apparatus, said input apparatus apparatus being removable from said handset for operation thereon to control the position of said cursor. Constien teaches coupling the input device to a handset of portable telephone apparatus and coupling the input device to a handset of portable telephone apparatus, said input apparatus apparatus being removable from said handset for operation thereon to control the position of said cursor (see figs. 1 and 2 noting that the laptop computer of Bowers can take the form of the device of Constien, which comprises as telephone handset, and therefore noting that it would be obvious to add the features of the removable input apparatus of Bowers to the portable computer/telephone handset of Constien).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of Constien to said apparatus of Bowers in order to further expand on the features of a portable phone while maintaining the small size.

Referring to Claim 10, Takagi also teaches a battery accommodating portion 15 (fig. 3) for accommodating a battery that supplies power to the portable telephone apparatus 1 (fig. 3) when the input device 23a (fig. 3) is coupled to the handset of the portable telephone apparatus by the coupling mechanism 18 (fig. 3).

Referring to Claim 11, Takagi also teaches the input device having a first electric contact portion and the handset of the portable telephone apparatus having a second electric contact portion, wherein the first and second electric contact portions are electrically connected to each other when the input device is coupled to the handset by the coupling mechanism (see col. 5, lines 48-61).

Referring to Claim 13, Bowers also teaches said coordinate information transferred from the input device to the information processing device through a cable 66 (fig. 2).

Referring to Claim 14, Bowers also teaches the coordinate information transferred from the input device to the information processing device by wireless (see fig. 6).

Referring to Claim 15, Bowers also teaches the information processing device controlling the input device so that it functions as a keypad of the portable telephone apparatus when the input device is coupled to the predetermined portion by the coupling mechanism (see 50 of fig. 1) and functions as a pointing device when the input device is not coupled to the predetermined portion (see fig. 2).

Referring to Claim 16, Bowers also teaches said input device as a pointing device (see Claim 3 of Bowers).

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Referring to Claim 17, Bowers also teaches the pointing device as a mouse having at least a right-click key and a left-click key 46 (fig. 2).

Allowable Subject Matter

4. Claims 1-8 and 12 are allowed.

Regarding Claims 4 and 12, Bowers, Henderson, Ikehara, Constien and Takagi do not teach, alone nor in combination, a secondary battery, which is charged by the battery of the input device when the input device is coupled to the handset of the portable telephone apparatus by the coupling mechanism.

Regarding Claim 1, Bowers, Henderson, Ikehara, Constien and Takagi do not teach, alone nor in combination, a battery accommodating portion for accommodating a battery which is used to supply power to the information processing device when the input apparatus is coupled to the predetermined portion of the portable telephone apparatus by the coupling mechanism.

Response to Arguments


5. Applicant's arguments with respect to claims 9-11 and 13-17 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eugene Yun whose telephone number is (703) 305-2689. The examiner can normally be reached on 8:30am-5:30pm Alt. Fridays off.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on (703) 308-6739. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Eugene Yun
Examiner
Art Unit 2682

EY


LEE NGUYEN
PRIMARY EXAMINER